REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.114 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 3 has been canceled without prejudice or disclaimer. Claim 1 has been amended to incorporate therein the subject matter of canceled claim 3. Entry of such amendments is proper at least because a Request for Continued Examination is being filed herewith. See 37 C.F.R. §1.114.

In the Official Action, claims 1-6 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,361,768 (*Galleguillos et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

In a recent telephone conference with Examiner Shewareged, the Examiner noted that while the Declaration Under 37 C.F.R. §1.132 filed November 1, 2006, shows a quantitative difference in the color density values obtained in the inventive examples in comparison with the comparative examples, the Declaration does not provide an explanation of the significance of such quantitative differences in color density values. In response, submitted herewith is a second Declaration Under 37 C.F.R. §1.132 (hereinafter "Second Declaration") which explains the significance of such numerical values.

As discussed in the Second Declaration, inventive Examples 1 and 2 exhibited black and cyan color density values above 1.90, i.e., the color density was high and the printed image was clear. By comparison, Comparative Example 2 exhibited black and cyan color density values of less than 1.70, i.e., the color density was low and below a practical level. In addition, the color densities of Comparative Examples 3 and 5 were unmeasurable, and those of Comparative Example 4 and Comparative Experiment A were in the range of 1.70-1.90, i.e., the color density was slightly low and the printed image was blurred. In view of such

experimental results and explanation, it can be seen that employing the inventive ink jet recording medium can result in obtaining high color densities and clear printed images which show an improvement over various comparative examples.

As discussed above, independent claim 1 has been amended by incorporating therein the subject matter of claim 3. Applicants note that in view of such amendment, Comparative Example 4 discussed in the Declarations is not encompassed by the scope of claim 1.

The issues raised by the Examiner concerning the color density data and Comparative Example 4, have been addressed by the above comments. Moreover, it is noted that the First Declaration shows that the inventive examples exhibited additional improvements in various other ink characteristics including ink absorptivity, gloss, water resistance, light fastness and yellowing resistance. In view of the above, it is apparent that surprising and unexpected results can be attained by employing an ink jet recording medium in accordance with an aspect of the claimed invention.

Furthermore, as discussed in the previous response, Applicants note that *Galleguillos et al* fails to disclose at least one ink receptive layer containing polymeric organic particles which have an average particle diameter of 1 to 500 nm, as recited in claim 1, and as such fails to constitute an anticipation of such claim. In this regard, the Examiner has taken the following position in the Advisory Action mailed April 25, 2007:

> The 35 USC 102 rejection is not based on the doctrine of inherency. Furthermore, the prior art does not expressly disclose that the copolymer powder is completely dissolved. Thus the examiner interprets that there are still particles that are partially dissolved (with reduced particle size) and/or undissolved (with same particle size).

However, while the Examiner has asserted that the present rejection is not based on the doctrine of inherency, the Examiner's rationale clearly relies on an alleged inherent disclosure by *Galleguillos et al* of partially dissolved or undissolved particles. The standard for maintaining an anticipation rejection under 35 U.S.C. §102 is well established. "A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). Here, *Galleguillos et al* has no express disclosure of an ink receptive layer containing polymeric organic particles which have an average particle diameter of 1 to 500 nm. *Galleguillos et al* merely discloses a copolymer in the form of a fine powder with submicron particle size that is readily dissolved in water. There is no express disclosure of partially dissolved or undissolved particles. And certainly, *Galleguillos et al* has no express disclosure of the claimed particle diameter range. Clearly, *Galleguillos et al* has no express disclosure of polymeric organic particles which have an average particle diameter of 1 to 500 nm. Thus, the only possible rationale for maintaining the anticipation rejection is through a reliance on the doctrine of inherency.

As previously discussed, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent feature necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In the present case, the Examiner has asserted that the dissolved copolymer "may partially dissolve and may comprise reduced particle diameter" (emphasis added). The Examiner has merely alleged the possibility that the dissolved copolymer of *Galleguillos et al* may exhibit the claimed characteristics. As discussed above, however, the mere fact that a

certain thing may result from a given set of circumstances is not sufficient to establish inherency. In the present case, the Patent Office has failed to provide any evidence or scientific reasoning which establishes with the requisite certainty that (1) the copolymer fine powder is partially dissolved, and (2) such alleged partially dissolved particles have a particle diameter within the claimed range. Inherency cannot be based on mere possibilities or conjecture. But that is precisely what the Examiner has relied on in the present case. Simply put, the Patent Office has not met its burden of proof of establishing inherency with the requisite certainty.

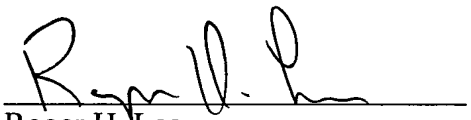
In light of the above, *Galleguillos et al* does not constitute an anticipation of the recited ink receptive layer containing polymeric organic particles which have an average particle diameter of 1 to 500 nm. Accordingly, withdrawal of the above rejection under 35 U.S.C. §102 is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: May 29, 2007

By: 

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